

**UNITED STATES DISTRICT COURT FOR THE
SOUTHERN DISTRICT OF NEW YORK**

LA QUINTA WORLDWIDE, LLC,

Plaintiff,

v.

TRIUMPH HOSPITALITY, LLC,

Defendant.

Civ. Action No. 1:20-cv-4688

COMPLAINT

Plaintiff La Quinta Worldwide, LLC (“Plaintiff” or “La Quinta”), by and through its attorneys, Foley & Lardner LLP, as and for its Complaint against defendant, Triumph Hospitality, LLC (“Defendant” or Triumph Hotels”), alleges as follows:

PRELIMINARY STATEMENT

1. This is an action for declaratory relief under 28 U.S.C. §§ 2201 to confirm Plaintiff’s right to use and license the slogan “Tonight La Quinta. Tomorrow You Triumph.” or “Tomorrow You Triumph” is permitted under the fair use doctrine, 15 U.S.C. 1115(b), and to confirm that La Quinta’s use of this slogan (in either format) does not infringe any rights of Defendant in its trademark under the Federal Trademark Act, as amended (the “Lanham Act”), 15 U.S.C. §§ 1051, *et seq.*, or under any analogous state law.

PARTIES

2. La Quinta is a Nevada limited liability company with a principal place of business at 22 Sylvan Way, Parsippany, NJ 07054.

3. Upon information and belief, Triumph Hotels, is a New York limited liability company, with an address at 1633 Broadway, 46th Floor, New York, NY 10019.

JURISTICTION AND VENUE

4. This Court has subject matter jurisdiction over this action pursuant to 15 U.S.C. § 1121, 28 U.S.C. §§ 1331, and 1338(a) and (b), and pursuant to the principles of supplemental jurisdiction under 28 U.S.C. § 1337, because this case arises under the Lanham Act, as amended, 15 U.S.C. §§ 1051, *et seq.*

5. This Complaint also arises under the Federal Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202 *et seq.* based on the declaratory judgment sought by La Quinta due to Triumph Hotel's repeated and ongoing accusations against La Quinta for trademark infringement and threatened litigation, thereby giving rise to an actual case or controversy.

6. Venue is proper in this district under 28 U.S.C. § 1331(b)(2), in that Defendant is based in this judicial district and a substantial part of the events or omissions giving rise to the claim occurred in this district.

BACKGROUND OF PLAINTIFF AND THE TRADEMARKS AT ISSUE

7. For over fifty years, La Quinta, its licensees, and its predecessors in interest have been providing hotel services in the United States and worldwide under the name LA QUINTA.

8. As a result of its widespread, continuous, and extraordinarily successful use of the LA QUINTA name to identify hotel services La Quinta owns valid and subsisting rights to the trademark LA QUINTA.

9. The LA QUINTA trademark is the subject of numerous trademark registrations in the United States Patent and Trademark Office (“USPTO”), including but not limited to the following:

MARK	REGISTRATION NO.	GOODS & SERVICES
LA QUINTA	1080641	Hotel/Motel Services
	3064031	Hotel and motel services
	3704048	Hotel and motel services
LA QUINTA	4107821	Restaurant services
LA QUINTA	5510272	Hotel franchising services, namely, business management assistance in the establishment and operation of hotels and motels
	4513225	Hotel and motel services
	3704042	Hotel and motel services
	3704047	Hotel and motel services.
LA QUINTA	5461579	Downloadable mobile applications for making hotel and motel reservations; Downloadable mobile applications for informing consumers that their hotel/motel accommodations are ready; computer application software for mobile phones and mobile

	<p>devices, namely, software for facilitation of reservations for hotel and motel accommodations and hotel and motel services; computer application software for desktop, tablets, mobile phones and other mobile devices for informing consumers that their hotel accommodations are ready. : advertising, marketing and promotional services for hotels and motels; hotel and motel management services, hotel and motel operation services, business administration and management; hotel and motel business direction consultancy and administration; business management assistance in the establishment and operation of hotels and motels; hotel and motel franchising services, namely, consultation and assistance in business management, organization and promotion; hotel and motel franchising services, namely, offering business management assistance in the establishment and/or operation of hotels and motels; franchising, namely, consultation and assistance in business management, organization and promotion; advice in the running of establishments as franchises; provision and management of incentive programs, loyalty programs and member benefits related to hotel and motel services. providing facilities for recreation activities.</p>
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	Hotel and motel services; services for providing food and drink; restaurant; rental of temporary accommodation, catering and bar services; rental of rooms as temporary living accommodations; rental of meeting rooms and facilities, provision of conference, exhibition, banquet, social function and meeting facilities, booking hotel accommodation; hotel and motel accommodation and hotel and motel reservation services; provision of information relating to hotel and motel services; provision of information via communication and computer networks, and via mobile devices relating to hotel and motel services; providing information via a global communication network relating to hotel and motel services.
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10. Plaintiff's LA QUINTA trademark is well-known and indeed famous for hotel services.

11. At least as early as April 8, 2019, La Quinta adopted the slogan "Tonight La Quinta. Tomorrow You Triumph." for use in connection with its La Quinta branded hotel services.

12. La Quinta sometimes presents the slogan simply as "Tomorrow You Triumph."

13. La Quinta registered the slogan “Tomorrow You Triumph” in the USPTO, and is now the owner of Registration No. 5,830,346 for the slogan, which issued on August 6, 2019, for use in connection with “hotel, motel and restaurant services; making temporary lodging reservations for others.”

14. La Quinta also applied on November 19, 2018 (based on intent to use) to register the slogan “Tonight La Quinta. Tomorrow You Triumph.” The application was approved by the USPTO, but on March 31, 2020, Triumph Hotels filed an administrative proceeding opposing registration, alleging that the slogan is likely to cause confusion with its own name TRIUMPH HOTELS.

15. On March 31, 2020, Triumph Hotels also filed an administrative proceeding seeking to cancel Registration No. 5830346 for La Quinta’s trademarked slogan “Tomorrow You Triumph,” alleging that the slogan is likely to cause confusion with its own name TRIUMPH HOTELS.

DEFENDANT’S CLAIMED RIGHTS

16. Upon information and belief, Defendant owns or operates six hotels, all in New York City.

17. On information and belief, Defendant owns two trademark registrations for the full name TRIUMPH HOTELS for various hotel services.

18. On December 17, 2019, Defendant sent a cease and desist letter to La Quinta claiming that La Quinta’s use of the slogan “Tonight La Quinta. Tomorrow You Triumph.” infringed its claimed rights in its trademark TRIUMPH HOTELS.

19. The letter asserted that “[a]ny use of this proposed mark by La Quinta will cause consumers to believe falsely that La Quinta’s hotel services are being offered by or through Triumph, or that La Quinta has entered into a partnership or other relationship with Triumph in connection with the offering of hotel services with some consumers perhaps wondering whether La Quinta has merged or acquired Triumph,” and that La Quinta’s use of the said slogan was in violation of the Lanham Act.

20. The letter included the following demand (among others):

That La Quinta and its affiliated entities, including without limitation Wyndham Hotels & Resorts, Inc. (“Wyndham”), cease all planned or current use of the word TRIUMPH in connection with any proposed, planned or published promotional material, advertising, marketing or branding of hotel and related services, including without limitation in connection with the proposed mark “TONIGHT LA QUINTA. TOMORROW YOU TRIUMPH.”

21. The December 17, 2019 letter further demanded that La Quinta pay to Triumph Hotels attorneys’ fees, including an immediate payment of \$2,500.

22. In its December 17, 2019 letter, Triumph Hotels stated that its counsel was authorized to commence suit against La Quinta to enjoin its use of the slogan “Tonight La Quinta. Tomorrow You Triumph.” if La Quinta did not comply with its demands.

23. La Quinta responded to the December 17, 2019 letter on December 23, 2019, asserting, *inter alia*, that the allegedly infringing use was a fair use and that there was no likelihood of confusion (*i.e.*, there was no infringement).

24. In response, in a January 28, 2020 letter, Triumph Hotels continued to insist that La Quinta’s use of its slogan is an infringement of its claimed trademark rights and repeated its

threat to commence litigation if La Quinta did not comply with the demands in the December 17, 2019 letter.

25. Triumph Hotels' January 28, 2020 letter further repeated its threat that its counsel was authorized to commence suit without further notice.

26. Triumph Hotels continues to the date of this complaint to insist that La Quinta cease using its slogan in issue in any manner, and has never retracted its threats of suit contained in its December 17, 2019 or January 28, 2020 letter.

27. Although correspondence between the parties ceased during the Covid-19-related lockdown, rather than immediately commence suit for infringement, Triumph Hotels instead commenced administrative proceedings challenging La Quinta's right to register the slogan "Tonight La Quinta. Tomorrow You Triumph." or "Tomorrow You Triumph." The complaints in those proceedings allege the La Quinta's slogan is likely to cause confusion with its trademark TRIUMPH HOTELS.

28. While for now having simply filed administrative proceedings seeking a ruling that La Quinta's slogan is likely to cause confusion with Triumph Hotel's claimed trademark, Triumph Hotels still demands that La Quinta entirely cease use of the slogan, and the administrative proceedings do not in any way limit Triumph Hotels' ability to commence litigation to obtain injunctive or other relief, as it has repeatedly threatened, hence creating needless uncertainty and leaving a cloud over La Quinta's investment in and ability to continue using its slogan in issue without risk of liability.

29. La Quinta's deadline to respond to the first of the two administrative proceedings is June 18, 2020.

COUNT I

Declaratory Judgment of Fair Use Under 15 U.S.C. § 1115(b)

30. Plaintiff repeats, realleges, and incorporates by reference paragraphs 1 through 29 hereof, as though fully set forth herein.

31. La Quinta uses the slogan "Tonight La Quinta. Tomorrow You Triumph." or "Tomorrow You Triumph" only in advertising for its La Quinta hotels.

32. La Quinta does not use either version of the slogan independently of advertising for its La Quinta hotels.

33. The trademark LA QUINTA is a well-known or famous name for hotels, nationally and internationally, and its slogan plainly identifies La Quinta as the source of the hotel services being advertised by the slogan.

34. In all instances, the verb "triumph" is used in its primary descriptive sense to mean victory.

35. In no instance does the verb "triumph" in the phrase "Tonight La Quinta. Tomorrow You Triumph." or "Tomorrow You Triumph" refer to a hotel; it refers in the ordinary and primary descriptive sense of "triumph" to the customer.

36. In no instances does the verb “triumph” in the phrase “Tonight La Quinta. Tomorrow You Triumph.” or “Tomorrow You Triumph” refer to Defendant’s group of New York hotels.

37. In no instance does La Quinta’s slogan use defendant’s actual registered trademark TRIUMPH HOTELS.

38. In all instances, as used by La Quinta, the verb “triumph” no more refers to Triumph Hotels than does the noun “you” or the adverb “tomorrow.”

39. In the more than one year since La Quinta has been using the slogan “Tonight La Quinta. Tomorrow You Triumph.” or “Tomorrow You Triumph”, there has not been a single reported instance of confusion.

40. Similarly, despite over one billion impressions the slogan has garnered in the more than one year it has been in use, there has not been a single reported instance of confusion.

41. Triumph Hotels has likewise identified no known instances of actual confusion.

42. La Quinta’s use of the word “triumph” in its slogan “Tonight La Quinta. Tomorrow You Triumph.” or “Tomorrow You Triumph” is a fair descriptive use that does not infringe any rights of Triumph Hotels.

43. The phrase “Tonight La Quinta. Tomorrow You Triumph.” also follows a history of La Quinta using short alliterative phrases in advertising its own hotel services. For example, La Quinta owns registrations for “Promises Made. Promises Kept.” and “Proven Name. Proven Numbers.,” which similarly consist of short alliterative phrases.

44. Based on Triumph Hotel's demand letters, its accusations of trademark infringement contained therein and its repeated threats of litigation (never withdrawn); and based on Triumph Hotels' subsequent recent communications after the commencement of the two administrative proceedings, despite La Quinta's denials of infringement, a substantial, immediate, and real case or controversy exists between La Quinta and Triumph Hotels as to La Quinta's potential liability for its ongoing use of its slogan and threatened litigation concerning such allegations. A judicial declaration is necessary to determine the parties' respective rights.

45. A judicial declaration that La Quinta's continuing use of its slogan is a permitted fair use is necessary and appropriate so that La Quinta can ascertain its rights and prevent further injury to itself and risk of liability for its continued use of the slogan.

46. La Quinta is entitled to a declaration that its use of the slogan is a fair use.

COUNT II

Declaratory Judgment of Non-Infringement Under The Lanham Act and State Law

47. Plaintiff repeats, realleges, and incorporates by reference paragraphs 1 through 46 hereof, as though fully set forth herein.

48. Based on Triumph Hotel's demand letters, its accusations of trademark infringement contained therein and its repeated threats of litigation (never withdrawn); and based on Triumph Hotels' subsequent recent communications after the commencement of the two administrative proceedings, despite La Quinta's denials of infringement, a substantial, immediate, and real case or controversy exists between La Quinta and Triumph Hotels as to La Quinta's potential liability for its ongoing use of its slogan and threatened litigation concerning such allegations. A judicial declaration is necessary to determine the parties' respective rights.

49. A judicial declaration that La Quinta's continuing use of its slogan is not likely to cause confusion with and therefore does not infringe Triumph Hotel's claimed trademark is necessary and appropriate so that La Quinta can ascertain its rights and prevent further injury to itself and risk of liability for its continued use of the slogan.

50. La Quinta is entitled to a declaration that its use of the slogan does not infringe any rights of Triumph Hotels under 15 U.S.C. §§ 1114 and 1125(a) or any analogous state law.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff requests judgment against Defendant as follows:

1. Declaring that Plaintiff's use of its slogan "Tonight La Quinta. Tomorrow You Triumph." or "Tomorrow You Triumph" is a permitted fair use.
2. Declaring that Plaintiff's use of its slogan "Tonight La Quinta. Tomorrow You Triumph." or "Tomorrow You Triumph" does not infringe any rights of Defendant.
3. Directing the TTAB to terminate with prejudice the two administrative proceedings concerning Plaintiff's slogan "Tonight La Quinta. Tomorrow You Triumph." and "Tomorrow You Triumph."
4. Declaring that this is an exceptional case pursuant to Section 35(a) of the Lanham Act and awarding Plaintiff its costs and reasonable attorneys' fees thereunder (15 U.S.C. § 1117(a)).
5. Awarding such other and further relief as the Court deems just and proper.

Dated: June 18, 2020

Respectfully submitted,

/s/ Jonathan E. Moskin

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